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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/755,541
Filing Date: January 05, 2001
Appellant(s): ROTHSCHILD, ANTHONY R.

Todd E. Fitzsimmons
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/3/2010 appealing from the Office action mailed 8/10/2009.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

62, 65, 68-70, 73, 75-77, 81, 84, 86-90, 92-95.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

6,205,432	GABBARD et al	3-2001
6,285,987	ROTH et al	9-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 62, 65, 68-70, 73, 75-77, 81, 84, 86-90 and 92-95 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al (US6205432) in view of Roth et al (US6285987).

Regarding claims 62, 65, 68, 75, 81, 87, 89, 90, 92, 94, 95,

Gabbard et al teaches a system whereby advertising is selectively inserted into (Internet, i.e. WAN) emails sent by senders to recipients [abstract]. Gabbard et al teaches that the emails may be sent using “web mail” and that the ads are inserted before being delivered to the identified recipients [column 2: lines 19-23, 4:33, 10:8]. This arrangement of web mail is taken to provide the web server including an advertising application that permits communication data to be submitted that includes the message and the recipient email address. Gabbard et al teaches that the ads may be automatically selected and inserted according to user demographics [abstract] which provides a teaching that there are a plurality of stored ads to choose from. Gabbard et al teaches that an implementation of the invention may include a web-based “free” email service [10:8] which is taken to provide compensation to the users of the free email service, whether they be senders benefiting from the advertising subsidization or receivers benefiting from the advertising subsidization, especially where both sender and receiver have registered as part of the free web-based email service. Gabbard et al teaches advertising to be targeted (selected) according to user demographics or commitments to advertisers. Gabbard et al contemplates that “other criteria can be used without departing from the spirit of the invention” in order to accomplish the targeted advertising [10:20-23], but Gabbard et al fails to explicitly teach targeting advertising according to the subject matter or content of the email message/body itself. Roth et al also teaches advertising that is automatically inserted according to advertisers’ targeting criteria when an advertising opportunity (view-op) presents itself. While Roth et al teaches advertising to appear on web pages, he nonetheless teaches

Art Unit: 3622

that the ad chosen to be shown on that webpage/screen can be targeted according to several factors including both the demographics of the user and the keywords of the content being read by that user [abstract, 2:14-17, 10:62, 14:24-25]. Given the motivation provided by Gabbard et al to seek other known advertising targeting criteria, it would have been obvious to one of ordinary skill at the time of the invention to have also used the keywords (i.e. subject matter, content) in Gabbard et al's email messages so that the advertising can be more relevant to the current view-op, thus providing more effective advertising. It is further noted that Gabbard et al's emails can be represented by web pages where the emails are provided as part of a "web mail" application.

Regarding claims 69, 76, 77, Gabbard et al teaches that an implementation of the invention may include a web-based "free" email service [10:8] which is taken to provide compensation to the users of the free email service, whether they be senders benefiting from the advertising subsidization or receivers benefiting from the advertising subsidization, especially where both sender and receiver have registered as part of the free web-based email service.

Regarding claims 70, 73, Gabbard et al does not explicitly state that the advertisement can be clicked, however Official Notice is taken that Internet ads were well known at the time of the invention to have included a link to further information about the advertised product and it would have been obvious to one of ordinary skill at the time of the invention to have enabled the ability for an interested user to request and receive more information about an advertised product. It would have been obvious to one of ordinary skill at the time of the invention to have hosted the ad content and/or the

Art Unit: 3622

additional ad content on any server that can be accessed via the network as a mere design choice. Doing so provides a step of receiving the additional advertising data at the particular server before sending it to the requesting user.

Regarding claims 84, 86, inserting an advertisement into the emails of Gabbard et al is taken to inherently provide creating a copy or “instance” of the advertising object from the ad server into the email itself.

Regarding claims 88, 93, the sender of Gabbard et al is able to specify several things including his recipient and the message content. Gabbard et al’s selection of particular ads targeted to the recipient and the obviousness of targeting to content can be taken to provide the feature of allowing the sender to specify advertisement-type data that is used to select the advertisement. Further, providing the user profile data (such as demographic information) by the user to the system is taken to address the limitation of providing advertisement-type data, as this profile information is a basis for the type of advertisement selected according to that user-provided information. Information that you are a male of a certain age represents advertisement-type data, whereby that data is used as at least a partial basis to select targeted advertisements suitable for such a person.

(10) Response to Argument

Applicant argues that Roth et al fails to teach ad selection based on content because ads are selected according to a highest bidder. A view-opportunity (view-op) triggers an ad selection process. The ad selection process includes collecting bids

Art Unit: 3622

where there is a match in keyword/content. The selection process also includes steps of not bidding when keywords/content are not matched. Content therefore is used in the advertisement selection process. Applicant's open-ended claims do not preclude the presence of bidding as part of the ad selection process. Further, applicant's claims call for "using at least a portion of the content of said communication data to automatically select at least one advertisement". Both the open-ended nature of applicant's claims (*preamble states "comprising"*) and the "using at least a portion of the content" indicate that other considerations may be used for selecting the ad. Therefore bidding on content-appropriate opportunities and selecting an ad according to highest bid clearly falls within the scope of the claim. Further, consider the situation where the advertisers of Roth et al are such that a content-appropriate view-op results in only one advertiser interested in bidding on that content opportunity. His advertisement will be selected regardless of the bid amount; it would be chosen because it is the *only* advertiser-specified content match. Further still, applicant summarizes the content-based ad selection step of claim 62 as being supported by page 16 line 19 to page 17 line 5 of the instant specification. Examiner sees page 17 lines 1-5 as being the most relevant ["The advertising application 114 would then create an interactive advertisement from data containing within the populated e-mail communication page (e.g., sender name, subject matter, content). The personal communication, containing 5 the interactive advertisement, would be routed to the recipient network device 130."]. Applicant offers no discussion regarding how many advertisers might use the system, nor how to resolve a situation where several advertisers each desire their advertisement to appear for a common content context such as "basketball". Roth et al would take the highest advertiser bidding on the matched content of football,

Art Unit: 3622

but using bids as part of the content-based selection process should not prevent Roth et al from being applied to the claim language. The content-based selection process of Roth et al may include bidding, but the selection process is clearly not entirely based on bids alone. Roth et al's ad selection process is clearly predicated on content matching. Lastly and inasmuch as pertinent, using content to select a particular advertisement from a plurality is indeed fairly described as content-targeted advertising – although applicant appears to disagree.

Applicant argues that Gabbard et al and Roth et al are directed toward different technologies: emails vs. webpages. However, each are endeavoring to determine appropriate advertising to provide with screen-displayed content to a reader. They are seeking to solve similar problems – that is, techniques to display not merely *any* advertising, but *targeted* advertising. Each were at the time of the invention classified in 705/14 by the examiners. Further, it is further noted that Gabbard et al teaches that his advertisement-enhanced emails can be accomplished as web mail – which is a web-based email client that displays email messages *as web pages*. This provides further reasoning why one of ordinary skill would seek teachings from Roth et al when contemplating how to include Gabbard et al's "other criteria (*which*) can be used without departing from the spirit of the invention" in order to accomplish the targeted advertising [Gabbard et al at 10:20-23].

Applicant has argued that web pages are public and emails are private and further that there are privacy/legal limitations regarding who can access emails. Bear in mind that this rejection is based on the base reference of Gabbard et al who

Art Unit: 3622

presumably already has authority to access user's emails *in view of* a modification based on Roth et al that would have been obvious to one of ordinary skill. The webpage-based teachings of Roth et al can be suitably used for example on a local Intranet or LAN where the webpages are not entirely "public". The notion of private content vs. public content would nonetheless not diminish the predictable improvement to advertising when it can be based upon not only the user, but also the content that the user is currently seeing/reading.

Applicant argues that combining Gabbard et al and Roth et al would violate the Electronic Communications Privacy Act of 1986 (ECPA). Examiner is not aware that determinations of obviousness must also be weighed in view of privacy policies. Policies which may change or be done away with. Insofar as pertinent, examiner has not been shown how the current claims can be practiced without violating the same ECPA policy (interception of email), but again the examiner is not concerning himself with violations or non-violations of privacy policies. Nonetheless, it is absolutely routine (and therefore obvious) for information service providers to ask for user permission before they collect or otherwise share or use data of their users.

Applicant argues that the keywords of Roth et al are collected beforehand (stored in database tables) and therefore his methods cannot translate to emails which are written and then (more or less) immediately sent. Examiner disagrees. First, it is noted that Gabbard et al's emails can be represented by web pages where the emails are provided as part of a "web mail" application. Further, Roth et al determines webpage keywords when the view-op is created (i.e. when the web page is requested by a web

Art Unit: 3622

browser). Roth et al's noted database tables 16B include 4 tables (HUD, SOD, CUD, AAD) none of which include any indication of webpage keywords [cols 9:49-10:30]. The 5th table (VOD) is a *temporary* data table which is populated at the time of the view-op [10:31-37] and sent to the ad selection process (bidding agents) and is populated with freshly-retrieved data such as the user's browser type making the HTTP request [10:51], the user's IP address [10:45] and the "keywords which *appear* on the site" [10:62]. Nowhere in Roth et al is it stated that web sites are spidered ahead-of-time with keywords for the sites being pre-stored in a database. Therefore, arguments that emails cannot be collected beforehand are moot. Applicant's questioning that the content data is not entirely "freshly-retrieved" does not provide concrete evidence that the content was predetermined and cached. Clearly Roth et al uses freshly-retrieved data as part of the content-based advertisement selection. Otherwise how can a user's IP address which is inserted into the same temporary table be determined ahead of time?? How can a user's browser type be determined ahead of time?? Applicant's conclusion that because keyword data is not provided by the browser, it must be stored in the database – is unfounded. Applicant is ignoring the fact that the advertising server can analyze the page/email for content as needed; examiner has provided an articulation of why one of ordinary skill would do that. One of ordinary skill could use the techniques of Roth et al's web page content-targeted advertising with either a webpage-based web mail message or a standalone email client. In either case one of ordinary skill would expect that determining the content of the message on the screen (whether it was a webmail or as a standalone email) would be a predictable

Art Unit: 3622

improvement for the advertising selection process. Doing so would result in an advertisement that is highly relevant to the subject matter that the reader is currently seeing, and thereby would provide for effective advertising. Determining the content of the page at the time the page is requested (i.e. NOT spidering the page ahead of time) would be an obvious way to provide for advertising that is relevant to the *current content* on that webpage, as it is well known that web page content can change often.

KSR guidelines [Federal Register Vol. 72, No 195 – Examination Guidelines for Determining Obviousness Under 35 USC 103 in view of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*]

- *When considering obviousness of a combination of known elements, the operative question is thus "whether the improvement is more than the predictable use of prior art elements according to their established functions. "*
- *The rationale to support a conclusion that the claim would have been obvious is that a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art. One of ordinary skill in the art would have been capable of applying this known technique to a known device (method, or product) that was ready for improvement and the results would have been predictable to one of ordinary skill in the art.*

Applicant argues that Roth et al fails to teach how email information would be collected. Indeed Roth et al doesn't, so we turn to one of ordinary skill who was tasked by Gabbard et al with considering "other (targeting) criteria". One of ordinary skill would have found it obvious to analyze the emails of Gabbard et al's in an attempt to determine their content so that better targeted advertising could take place. Applicant notes that sometimes web pages include meta tags which can be used to assist in the determination of the page's content. While this is true, Roth et al does not necessarily use that technique. In fact, Roth et al does not appear to explicitly state examples of

Art Unit: 3622

how (at the time of the view-op) he determines keywords for a page. He assumes that one of ordinary skill would be able to accomplish such a determination at the time of view-op; examiner believes one of ordinary would indeed understand that a parsing technique to locate frequently occurring words would be one example. Applicant's claims do not require any particular technique for determining content. Nor does applicant's disclosure provide any inkling to a reader how to accomplish determination of content (applicant is again invited to indicate where such a teaching may have been missed by the examiner). It is noted that the examiner has not determined this feature of applicant to be non-enabled. For the same reasons that no 112 ¶ 1 rejection was made on applicant's claim for determining the content of an email (where there are no meta-tags to rely on, and where the emails cannot be spidered ahead of time and where applicant's disclosure has provided ZERO GUIDANCE on HOW to determine the content of an email), it has been previously assumed that the same routine skill to determine 1) keywords/content of Roth et al using a parsing or spidering technique to identify keywords in the content without rely on meta-tags could be used to determine 2) applicant's email content determination. Applicant's arguments that question how Roth et al would select an ad for an email message stating "my boss has me jumping through hoops" are moot when applicant's claims and disclosure fail to offer a solution. Or worse, applicant's arguments that one of ordinary skill would not know how to determine the content of an email serve to erode applicant's own presumed enablement of determining the content of an email.

Applicant states: *"There is ample evidence to shows that it was commonplace in 1999 to use meta-data to identify keywords on websites.... There is no evidence, however, that such a*

Art Unit: 3622

technique was (or could have been) used in 1999 to identify keywords on emails. Thus, the current ground of rejection is improper."

It is noted that applicant has failed to respond to examiner's query as to where support can be found in the instant disclosure regarding how to determine the content of emails. The examiner therefore assumes that there is no particular *explicit* support in the instant disclosure. Examiner's present conclusion that applicant's determination of email content IS enabled (even while the details of how to accomplish such are unstated) ALSO MUST support a conclusion that determining Roth et al's email content (without using meta tags) would be within the abilities of one having ordinary skill.

Applicant argues claims 88 and 93 by stating that submitting "recipient data" is not "advertisement-type data". Examiner disagrees. Any data provided by a user that is used as a basis to select an advertisement qualifies as "advertisement-type data". Providing profile details to the system that the user enjoys basketball qualifies as advertisement-type data - as this data is used in the determination of the types of advertisements that would be relevant to the situation. Applicant argues that the references cannot "allow the sender to select a type of advertisement". It is noted that while applicant has disclosed an embodiment of the sender selecting the particular ad to include in the email, the claimed embodiments are directed to a different embodiment where the advertising application selects the advertisement; the user is not believed to be selecting a particular advertisement. The claims do call for the user to send advertisement-TYPE data. Any data sent by a user (recipient identification, user profile data, email subject, email content, etc.,) which is used as a basis for the *system* to choose an advertisement is taken as advertisement-type data. If the user sends data

Art Unit: 3622

indicating or inferring a like for basketball, he may receive an advertisement related to basketball; the advertisement type and the data used to determine the interest of basketball both are basketball-type data.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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